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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,961	01/18/2002	Joseph R. Berger	44657-AAA-PCT-US/JPW	3958

7590

01/14/2004

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EXAMINER
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TRAVERS, RUSSELL S

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/052,961	<b>Applicant(s)</b> BERGER, JOSEPH R.	
	<b>Examiner</b> Russell Travers, J.D., Ph.D	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 59-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 59-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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The amendment filed October 14, 2003 has been received and entered into the file.

Applicant's arguments filed October 14, 2003 have been fully considered but they are not deemed to be persuasive.

Claims 59-64 are presented for examination.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 59-61 and 63 are rejected under 35 U.S.C. § 102(b) as being anticipated by Eisenberg. Please note Eisenberg teaches oxandrolone orally administered at 1.25 to 20 mg., encompassing those dosages herein claimed.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 59-64 are rejected under 35 U.S.C. § 103 as being unpatentable over Pike et al and Eisenberg.

Pike et al and Eisenberg teach the claimed oxandrolone compositions as old and well known in combination with various pharmaceutical carriers and excipients in a dosage form. This medicament is taught as useful for treating various maladies.

Claims 59-64, and the primary references, differ as to:

- 1) the employment of these medicaments by conventional means and routes, and
- 2) administration of the medicaments for specific therapeutic goals.

Claims 59-64 specifically require conventional pharmaceutical compositions and delivery routes. Pike et al (claims 1-8, and column 4, lines 35-36) and Eisenberg employed the claimed oxandrolone in a dermal form, subcutaneously, IM, trans dermal, and orally, not specifically reciting the exact formulation. The skilled artisan would have seen conventional compositions, and the administration of these compositions by conventional means as residing in the skilled artisan purview.

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Applicant's attention is drawn to In re Dillon, 16 USPQ2d 1897 at 1900 (CAFC 1990). The court sitting in banc ruled that the recitation of a new utility for an old and well known composition does not render that composition new.

### **RESPONSE TO ARGUMENTS**

Examiner apologizes for any inconvenience, or confusion caused by the inadvertent numbering error. Eisenberg clearly stated those oxandrolone dosages meeting the dosages herein envisioned, thereby providing a clear anticipation for the presented claims. Newly presented claims necessitate the above newly presented rejections.

Applicant's arguments with regard Eisenberg's to dosages, excipients, medicaments, or intended use are unconvincing. Attention is directed to the "comprising" language employed in the instant claims. This verbiage enables the use of any excipient, active ingredient or other compound, thus, allowing the broad teaching of Eisenberg to anticipate the instant claims. Additionally, Applicant's attention is again drawn to In re Dillon, 16 USPQ2d 1897 at 1900 (CAFC 1990). The court sitting in banc ruled that the recitation of a new utility for an old and well known composition does not render that composition new. With regard to the administration levels taught by the prior art, the skilled artisan would assume if Eisenberg administered the medicament in multiple doses, this regimen would have been disclosed. Examiner

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assumes the underlying article by Eisenberg would clarify this issue raised by Applicant. If the instant application is appealed, the Eisenberg article will be obtained.

Examiner notes the argument with regard to Pike et al priority date is unconvincing. At the present time, the effective filing date of the instant application is October 20, 1993 some 5 months subsequent to the Pike et al filing date. Absent a status change with regard to Applicant's effective filing date the Pike et al patent is prior art useful in obviating the instant claims.


**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE

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MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication should be directed to Russell Travers at telephone number (703) 308-4603.

A handwritten signature in black ink, appearing to be 'RT' or similar initials, enclosed within a circular or oval shape.

**Russell Travers J.D., Ph.D.  
Primary Examiner  
Art Unit 1617**